

REMARKS

The Official Action of 24 March 2006 has been carefully considered and reconsideration of the application as amended is respectfully requested.

Claim 1 has been amended with the incorporation of the recitations previously in claim 2, and the latter claim has been canceled. Claim 1 has also been amended in the manner courteously suggested by the Examiner in paragraph 2 of the Official Action whereby to remove the basis for the Examiner's rejection under 35 USC 112, second paragraph. Claim 1 has also been amended to clarify that the recited ink composition is a violet ink composition, and new claim 10 has been added for an ink set comprising the violet ink composition in combination with yellow, magenta and cyan ink compositions. Support for these recitations appears in the specification as filed at, for example, page 1, lines 15-23 and page 2, lines 24-28.

Claims 1 and 3-9 stand rejected under 35 USC 102(e) as allegedly being anticipated by Kubota US 2005/0075449. Applicant respectfully notes that the 102(e) date of this reference is December 30, 2003, which is **after** the filing date of Applicant's Japanese priority application, i.e., January 14, 2003. Applicant submits herewith an English translation of the Japanese priority application (JP 2003-006032) to overcome the reference in accordance with the provisions of MPEP 201.15.

Claims 1, 3 and 5-9 also stand rejected under 35 USC 102(e) as allegedly being

anticipated by Kubota et al US 6,824,262, and claim 4 stands rejected under 35 USC 103(a) as allegedly being unpatentable over Kubota et al US 6,824,262 in view of Sekioka et al. Applicant respectfully notes that Kubota et al US 6,825,262 was **not** applied against the subject matter of claim 2, which has now been incorporated into the main claim. Moreover, Kubota et al is disqualified as prior art under the provisions of 35 USC 103(c). In this connection, the undersigned makes the following statement on behalf of Applicant:

"The present application and Kubota US Patent 6,824,262 were, at the time the invention of the present application was made, owned by the same company, Seiko Epson Corporation."

Claims 1,3 and 5-9 stand rejected under 35 USC 102(e) as allegedly being anticipated by Kataoka et al, and claim 4 stands rejected as allegedly being unpatentable over Kataoka et al in view of Sekioka et al. Applicant respectfully notes that these rejections were not applied against the subject matter of claim 2, which has now been incorporated into the main claim. Accordingly, the amendment to the claims is respectfully believed to remove the basis of the rejections based on Kataoka et al, which reference does not show or suggest the recited acid value of the recited resin. Applicant also respectfully notes that Kataoka et al is not properly citable under 35 USC 102(e) as of its international filing date because the international application was not published in English.

Claims 1-9 stand rejected under 35 USC 102(e) as allegedly being anticipated by

Redfearn et al. Applicant respectfully traverses this rejection.

The claims as amended are directed to a **violet** ink composition, whereas the ink composition described in the cited reference is **black**. In the reference, the black ink composition comprises a “violet pigment dispersion 12” in which “Pigment Violet 23 (10wt%): “styrene acrylate resin having an acid number of 190 and Tg of 70°C”=10:0.15 (100:1.5). In particular, Redfearn et al disclose “black ink 6” containing the above “violet pigment dispersion 12” and a black dispersion 6” in column 8, middle section to column 9, middle section (Tables 8 and 9).

Since the cited art does not show a violet ink composition as claimed, it cannot be considered to anticipate the claims. Moreover, since the intended purpose of the Redfearn et al invention is to provide an improved pigment based **black** ink (see Redfearn at, e.g., column 1, lines 5-7, and column 2, lines 22-24 and 37-41), there could have been no motivation, absent the hindsight provided by the present specification, to modify the Redfearn composition to arrive at the claimed **violet** ink composition. See MPEP 2143.01(V) (“If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.”). In the absence of a motivation to modify the reference, the reference also cannot be considered to render obvious the invention as claimed. See MPEP 706.02(j)).

Claims 1-3 and 5-9 stand rejected under 35 USC 103(a) as allegedly being unpatentable over Kashiwazaki et al. Claim 4 stands rejected under 35 USC 103(a) as allegedly being unpatentable over the aforementioned combination of references and further in view of Sekioka et al. Applicant respectfully traverses these rejections.

The claimed invention is based at least in part on Applicant's discovery that, with a violet ink composition comprising pigment violet 23, it is possible to form print images with excellent gas fastness, without degrading the print appearance, by including in the ink composition, as dispersant, a water-soluble styrene-(meth)acrylic resin in the recited amount.

The criticality of the recited amount of resin is shown in the Examples appearing in the specification, as next discussed.

As can be seen at pages 12-14 of the specification, pigment ink compositions of Examples 1-3 were prepared comprising the claimed components with the styrene-acrylic acid dispersant present within the claimed percentage range. As can be seen at page 14, line 31 to page 16, line 28, pigment ink compositions of Comparative Examples 1 and 2 were prepared with the claimed components but with the styrene-acrylic acid dispersant present in an amount below (Comparative Example 1) or above (Comparative Example 2) the claimed percentage range. The pigment ink compositions of the Examples and Comparative Examples were evaluated using the evaluations described in the specification at page 16, line 30 to page 19, last line. As shown on Table 1 on page 20 of the specification, the ink compositions of the

Examples performed better than the ink composition of Comparative Example 1 in the test for gas fastness, and performed better than the ink composition of Comparative Example 2 in the test for glossiness.

Kashiwazaki et al do not show or suggest the claimed combination of components or the criticality of including the claimed resin in the combination in the recited amounts. Rather, Kashiwazaki et al describe an ink composition that can be made by picking and choosing from among a large number of possible colorants (column 4, line 60 to column 5, line 59), a large number of possible resins (column 6, line 61 to column 7, line 5), a broad range of percentages for the large number of possible resins (column 7, lines 14-16), and a broad range of acid values for the large number of possible resins (column 7, lines 4-5). Kashiwazaki et al do not show or suggest any relationship between the acid values and the dispersant type. Moreover, Kashiwazaki et al teach a preference for a resin and a percentage of resin that is outside the scope of the claims, as next discussed.

The claims require pigment violet 23 resin dispersant within a range of 100 : 30-80 (solid content). Kashiwazaki et al teach pigment : dispersant should be equal to 10 : 3 to 10 : 0.5 (100 : 30-5) (column 7, lines 14-16). Although this described range touches the endpoint of the claimed range, the preferred embodiment exemplified in the reference teaches an amount outside of the claimed range. Specifically, at column 14, Kashiwazaki contains a specific example of "Blue ink BL-1" ink composition, which includes pigment violet 23. However, the preferred dispersant in the example is not the claimed dispersant, the acid value of the resin

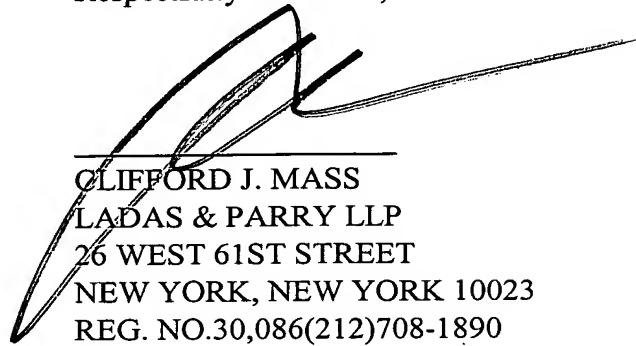
(360) is outside of the claimed range, and the ratio of the pigment to dispersant of 5 : 1 (100 : 20) is below the claimed range (compare with Comparative Example 1, discussed above).

In view of the need to pick and choose from among a huge number of possibilities without adequate guidance in the reference, Applicant respectfully submits that the reference cannot be used to set forth even a *prima facie* case of obviousness for the invention as claimed. See *In re Baird*, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) (“Given the vast number of diphenols encompassed by the generic diphenol formula in Knapp, and the fact the diphenols that Knapp specifically discloses to be “typical,” “preferred,” and “optimum” are different from and more complex than bisphenol A, we conclude that Knapp does not teach or fairly suggest the selection of bisphenol A”). Moreover, Sekioka et al do not supplement the deficiencies in the primary reference, and the combination does not arrive at the claimed invention.

Accordingly, Applicant respectfully submits that the cited art is not competent to set forth a *prima facie* case of obviousness for the invention as now claimed. Moreover, even if the art could set forth a *prima facie* case, the evidence in the specification of the criticality of the claimed amount of the resin would be sufficient to rebut such *prima facie* case (see discussion above).

In view of the above, Applicant respectfully submits that all rejections and objections of record have been overcome and that the application is now in allowable form. An early notice of allowance is earnestly solicited and is believed to be fully warranted.

Respectfully submitted,



CLIFFORD J. MASS
LADAS & PARRY LLP
26 WEST 61ST STREET
NEW YORK, NEW YORK 10023
REG. NO.30,086(212)708-1890